

### **REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration of this application in view of the present amendments and the following remarks. By this amendment, claims 4, 7, 9-11, 13, 20 and 23 are amended. As a result, upon entry of this amendment claims 4, 7-17, 20, 21 and 23-44 are pending in this case, with claims 4, 7, 8, 14, 15, 20, 23, 24, 27 and 36 being independent claims, and claims 27-44 having been previously withdrawn from prosecution in response to a restriction requirement. It is believed that no fees are due for the consideration of this paper. However, if fees are due, the Commissioner is authorized to charge such fees to deposit account number 13-2855. A copy of this paper is enclosed.

### **Applicants' Interview Summary Record**

On March 7, 2006, Applicants' attorney, Scott E. Baxendale, conducted a personal interview with Examiner Mendiratta regarding the present application and the Examiner's bases for rejection of several of the pending claims. Mr. Baxendale and Applicants again thank Examiner Mendiratta for his time and consideration in granting this telephonic interview after final rejection.

Mr. Baxendale and Examiner Mendiratta first discussed claims 7, 20 and 23, and in particular whether the applied references would be overcome by amending the claims to recite actuation of the mechanically functional combat component or weapon by direct engagement by a user, and not by the movement of the game piece or the operation of the distance measuring device. Examiner Mendiratta agreed that such amendments may overcome the launch mechanism disclosed in McKay, but indicated that such amendments would likely require additional searching.

Next, Mr. Baxendale and Examiner Mendiratta discussed the rejection of claim 4 in view of McKay alone or in combination with Kulesza et al. Mr. Baxendale pointed out that the Office action offered no actual evidence supporting the conclusory statements regarding a motivation for combining McKay and Kulesza et al. to make a device that is acceptable for visually challenged players. In response, Examiner Mendiratta asserted that he believed claim 4 to be construed so broadly as to cover any toy making a sound when it moves across a surface, with the observed movement of the toy providing a visual indication of the distance

traveled and with the sound providing an audible indication of the distance traveled. Mr. Baxendale disagreed in view of the recitation in claim 4 of the distance measuring device being a component of the game piece and being disposed within the base of the game piece, thereby precluding movement of the game piece itself from being a visual indication of distance provided by a distance measuring device. Examiner Mendiratta then suggested adding additional structure of the distance measuring device providing the visual and audible distance indications. Examiner Mendiratta further indicated that he would consider Applicants arguments regarding the legal insufficiency of the motivation for combining the references provided in the Office action.

Mr. Baxendale and Examiner Mendiratta next discussed the rejection of claim 8 in view of McKay. Mr. Baxendale reasserted the argument presented in Applicants' previous response that the ejector 30 of McKay is not configured to engage in object adjacent to the car 10 as recited for the second portion of the game figure character in claim 8. Mr. Baxendale discussed the McKay reference in detail with Examiner Mendiratta, pointing out that the ejector 30 is a catapult for launching the plane 12 and is not configured to engage objects adjacent to the car 10, and that there is no motivation whatsoever for extending the ejector 30 such that it could engage an adjacent object. Examiner Mendiratta agreed that claim 8 was allowable over McKay subject to additional searching.

Mr. Baxendale and Examiner Mendiratta also discuss claim 14 and the structures of Althaus allegedly corresponding to the components of the distance measuring device recited in claim 14. Mr. Baxendale pointed out that the structures identified as being wheels adapted for rotary engagement with a surface and rotating the axle upon movement of the game piece over the surface were in fact pendulum weights 40 attached to a shaft 42 that are suspended above the surface on which the hoop 10 is rolling, and are specifically disclosed as holding the shaft 42 against rotation as the hoop 10 rolls along the surface. Mr. Baxendale further pointed out that the bevel gear 48 asserted to correspond to the circular rack having a surface with circumferentially spaced indicia is not disclosed as having indicia disposed thereon, and that the numbers displayed by the counter 24 and alleged as being indicia disposed on the circular rack/bevel gear 48 are disposed on wholly separate components. In view of this,

Examiner Mendiratta agreed that claim 14 was allowable over the combination of McKay and Althaus subject to additional searching.

Finally, Mr. Baxendale and Examiner Mendiratta discussed the rejection of claim 15 and whether the applied references disclosed both providing an indication of distance of movement of a game piece over a surface and alternately displaying and shielding indicia indicative of a special characteristic of the game piece. Mr. Baxendale pointed out that McKay and Althaus only teach distance indications, and do not teach additional indicia indicative of special characteristics of their toys. Examiner Mendiratta agreed to consider Applicants' argument, and indicated that he believed that Althaus did not disclose indicia indicative of a special characteristic. Mr. Baxendale and Examiner Mendiratta further discussed the Potter reference previously asserted and overcome in this case. Mr. Baxendale explained as he had in previous responses and in the previous telephonic interview that the guidelines 240 and the numerals 242 and 243 alternately displayed by the pawns of Potter relate only to the distance traveled by the pawns and not to any special characteristics of the pawns. Examiner Mendiratta indicated he would also consider Applicants' arguments with respect to the teaching in Potter.

#### **Claim Amendments**

It is respectfully submitted that the claims as amended above are supported by the application as originally filed in the Patent Office on August 19, 2003, that the amended claims satisfy the written description requirement and the other requirements of 35 U.S.C. § 112, and that no new matter is being added. Claim 4 is amended to more clearly recite that the distance measuring device is actuated by movement of the game figure character over the surface, that the distance measuring device includes a visual indication component providing a visually perceptible indication of the movement of the game figure in increments of distance over the surface, and that the distance measuring device includes an audible indication component generating an audibly perceptible output indicating the movement of the game figure in increments of distance over the surface. The amendments to claim 4 are supported by the application as originally filed at least at Figs. 1-7 in the accompanying text pages 3-4, paragraphs 0022-0025. The distance measuring device is actuated by rotation of the wheel 20 as the game piece 10 is moved over the surface. The visual indication of

distance of movement is provided by circular rack 30 having circumferentially spaced first red marks 34 on an upper surface 30a. The upper faceplate 36 of the base 14 has a visual aperture 38 aligned with the marks 34 to sequentially display movement of the marks 34 as the rack 30 rotates to visually indicate the distance traveled. The audible indication of distance of movement is provided by clicker 28 engage by tooth extension 26a. Rotation of the wheel 20 as the game piece 10 is moved over the surface rotates the tooth extension 26a against the clicker 28 to provide an audible clicking sound once per revolution of the axle 18.

Claims 7, 20 and 23 are amended to more clearly recite that mechanically functional combat component or weapon is actuated by direct engagement of the combat component or weapon by the user of the action figure game piece, and not by movement of the game piece or by the distance measuring device. These amendments are supported by the application as originally filed at least at Figs. 1, 2, 8 and 9 in the accompanying text at pages 3-4, paragraphs 0025-0026. The distance-acting attack mechanism of Figs. 1-2 and the close-acting attack mechanism of Figs. 8-9 are actuated by direct engagement by the user of the game pieces 10, 10', respectively, and are not disclose is being actuated by the movement of the game pieces 10, 10' or by the distance measuring device. Claims 9-11 and 13 are amended to recite "distance measuring devices" having proper antecedent basis in claim 7 instead of "distance indicating devices" has previously recited.

Applicants respectfully submit that the amendments to the claims do not present new matter and do not raise new issues, and respectfully request entry of the present amendments and consideration of the claims as amended. Entry and consideration of the foregoing amendments as improving the form of the application are solicited. The amendments have the effect of narrowing the issues for consideration by Examiner Mendiratta, or on appeal, and were not earlier presented because, prior to the final Office action and Examiner Mendiratta's comments therewith, these amendments were not felt necessary to obtain allowance.

#### **Claim Rejection Under 35 U.S.C. § 102(b) and 103(a)**

Claims 7-9, 13, 20, 23 and 24 were rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as obvious over, McKay (U.S.

Patent No. 4,005,543), claims 4, 10, 11, 12 and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by McKay, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over McKay in view of Kulesza et al. (U.S. Patent No. 4,820,300), claims 14-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over McKay in view of Althaus (U.S. Patent No. 3,387,778), and claims 21, 25 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over McKay in view of Kulesza et al. and further in view of Althaus. Applicants respectfully traverse these rejections and request reconsideration in view of the following remarks in the discussions during the interview.

Referring first to the claims rejected in view of McKay alone, claims 7, 20 and 23 each recite an action figure game piece having a mechanically functional combat component configured to physically engage other action figure game pieces in simulated battles. As opined in the Office action, Applicants respectfully submit that the plane 12 of McKay is not a mechanically functional combat component as recited in claims 7, 20 and 23 because the plane 12 is not configured to engage other cars in simulated battles. Applicants reassert the arguments from the previously-filed response to McKay does not disclose a combat component configured to physically engage other game pieces, and does not suggest configuring the plane 12 to engage other planes or cars. In addition, claims 7, 20 and 23 are amended to more clearly recite that the combat component or weapon is actuated by direct engagement by the user, and not by movement of the game piece or the distance measuring device. McKay's plane 12 is launched when the actuator 70 engages latch 52 to release the ejector 30 as the car 10 is rolling across the surface. McKay does not disclose or suggest the user directly engaging these components to launch the plane 12. Therefore, claim 7, 20 and 23 and the claims depending therefrom are not anticipated or rendered obvious by McKay for this additional reason.

Claims 8 and 24 recite a second portion of a game figure character moveably connected to a first portion and moveable to engage an adjacent game piece when the second game piece moves from a second position to a first position under the biasing force of a spring. The ejector 30 identified in the Office action as corresponding to the second portion does not meet all the limitation recited in the claim as discussed during the interview. The ejector 30 is disposed within a groove 18 and a slot 32 of the car, and does not extend beyond

the perimeter of the car at any point during the movement of the ejector 30 along the slot 32 as can be seen from the various views of the car provided in Figs. 2-7 of McKay, and does not engage adjacent objects. Moreover, McKay does not suggest modifying the ejector 30 to have any portion thereof extend beyond the perimeter of the car in any direction, let alone in a manner such that the ejector 30 could engage an adjacent car. No other component of McKay's car is disclosed or suggested as being biased by a spring or engaging an adjacent car. For these reasons, neither claims 8 and 24, nor any claims depending therefrom, are anticipated or rendered obvious by McKay.

Turning now to the rejections in view of McKay and Kulesza et al., claim 4 is not rendered obvious by the proposed combination for multiple reasons. First, claim 4 recites a mechanically functional combat component in a similar manner as recited in claim 8. As discussed above, McKay does not teach or suggest a combat component as recited. Kulesza et al. does not teach or suggest any combat component, let alone a combat component as recited in the claims. Therefore, the combination of McKay and Kulesza et al. does not render claim 4 obvious for at least this reason.

Further, there is no suggestion or motivation for combining the references in the manner proposed in the Office action to yield the action figure game piece of claim 4 having visual and audible distance indications and, consequently, the Office action does not establish a *prima facie* case of obviousness. McKay offers no suggestion or motivation for adding a mechanism providing an audible indication of distance in addition to the visual indication provided as actuator 70 moves passed the indicia on the spoiler 74. Kulesza et al. teaches a toy vehicle having a speed indicating device providing a visual indication of a distance traveled and a sound producing assembly providing an audible indication, but Kulesza et al. does not teach or suggest adding a combat component as recited in claim 4 or any other component for engaging another vehicle or game piece as recited in claim 4. Therefore, neither reference provides the necessary suggestion or motivation for combining the references with each other in the manner proposed in the Office action.

Moreover, the Office action does not provide the necessary actual evidence of a suggestion or motivation for combining the references in the proposed manner. The Office action provides a conclusory assertion regarding combining the references based on children

being attracted to devices that produce sound, and audible indications making the device acceptable to visually challenged individuals. Applicants respectfully submit that these conclusory statements do not satisfy the requirement of actual evidence for combining two particular references in the proposed manner. The only suggestion of such a combination is provided in Applicants' own disclosure, the use of which constitutes impermissible hindsight analysis. *Orthopedic Equipment Co. v. United States*, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983) (It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.). It is clear that the prior art must make a suggestion of or provide an incentive for the claimed combination of elements for the examiner to be able to establish a *prima facie* case of obviousness. See, *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992); *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Because McKay and Kulesza et al. fail to disclose or suggest combining their teachings in the manner proposed in the Office action, and the Office action has not cited any other reference providing a suggestion or motivation for such a combination, it follows that the references cannot render claim 4 obvious.

Applicants wish to respond to Examiner Mendiratta's assertion that the distance measuring device as recited in claim 4 reads on any toy that makes a sound when it moves over a surface. Claim 4 recites that the distance measuring device is disposed within the base, and therefore is a separate component of the game piece and not the game piece itself. Further, claim 4 as amended more clearly recites the distance measuring device being actuated by movement of the game figure character over the surface, and further recites visual and audible indication components of the distance measuring device that generate visual and audible indications of movement of the game figure character in increments of distance in response to the actuation of the distance measuring device. Applicants respectfully submit that claim 4 as amended recites structure of the distance measuring device in addition to the previously recited limitations further distinguishing the action figure game piece, and that the distance measuring device distinguishes over the mere movement of a toy that also makes noise.

Regarding claims 10-12, Applicants respectfully submit that Kulesza et al. do not provide the teaching or suggestion of a second portion of the game figure missing from claim 8 as discussed above. Therefore, the combination of McKay and Kulesza et al. does not render claims 10-12 obvious for at least this reason. Regarding claim 20, Kulesza et al. does not suggest a combat component or weapon at all, and therefore does not provide the teaching or motivation of a combat component or weapon actuated by direct engagement by a user missing from McKay, and does not render claim 20 obvious in view of the proposed combination of the McKay and Kulesza et al. references.

Regarding the rejections in view of McKay and Althaus, Althaus does not recite a distance measuring device as recited in claim 14. Althaus does not disclose a wheel secured to an axle and engaging the surface. As discussed in the interview, the components of Althaus identified in the Office action as corresponding to the wheel are in fact circular weights 40 attached to the shaft 42 that are suspended by the side walls 14 to prevent rotation of the shaft 42 as the hoop 10 rolls along the ground. The weights 40 do not engage the surface. As further discussed, Althaus does not teach or suggest a circular rack having a surface with any indicia, let alone circumferentially spaced indicia as recited in claim 14. The indicia 30 identified in the Office action as being disposed on the gear 48 are in fact disposed on a wheel of a counter 24, and not on the gear 48. Moreover, Althaus provides no disclosure or suggestion of a surface of the gear 48 being visible through an aperture of a face plate. Therefore, Althaus does not teach a distance measuring device as recited in claim 14 for at least these reasons, and the combination of McKay and Althaus does not render claim 14 obvious as conceded by Examiner Mendiratta in the interview.

Claim 15 recites, *inter alia*, a display device alternately displaying and shielding indicium indicative of a special characteristic of a game piece. McKay and Althaus each teach only distance measuring devices, and neither teaches or suggests an additional display device for displaying indicia indicative of characteristics other than distance. Conversely, claim 15 recites both a distance measuring device and a display device for a special characteristic of the game piece. Even if McKay and Althaus were combined, the distance device of Althaus would be substituted for the distance device of McKay, and the combination would include only a single device for displaying distance, and not a distance



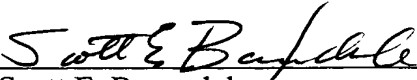
device and a separate display device as recited in claim 15. In addition, Potter similarly only discloses displaying distance indications. The guide lines 240 and the numerals 242 and 243 only relate to strides taken by the pawns 231, and do not relate to any other characteristic of the pawns 231. (See Potter, Fig. 10A and page 6, left-hand column line 54 through right hand column line 14). Therefore, claim 15 and the claims depending therefrom are not rendered obvious by McKay, Althaus and Potter for these additional reasons, and withdrawal of the rejection is respectfully requested.

Finally, regarding the rejection of claims 21, 25 and 26 in view of McKay, Kulesza et al. and Althaus, claims 21 and 25 recite limitations similar to limitations recited in claims 14 (circular rack including a first surface having circumferentially spaced a first indicia) and 15 (alternately displaying and shielding an indicium indicative of the presence or absence of a special characteristic of the game piece), respectively, that are not found in the applied references, including Kulesza et al. As a result, claims 21, 25 and 26 are patentable over the proposed combination for at least the applicable reasons as discussed above for the corresponding limitations.

For at least the foregoing reasons, reconsideration and withdrawal of the rejection of the claims and allowance of the currently pending claims are respectfully requested. Should the Examiner wish to discuss the foregoing or any matter of form in an effort to advance this application towards allowance, she is urged to telephone the undersigned at the indicated number.

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Respectfully submitted,

By:   
Scott E. Baxendale  
Registration No.: 41,605  
MARSHALL, GERSTEIN & BORUN LLP  
233 S. Wacker Drive, Suite 6300  
Sears Tower  
Chicago, Illinois 60606-6357  
(312) 474-6300  
Attorneys for Applicants